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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,932	05/26/2005	Sten Edstrom	G61-029	6877
21706	7590	11/17/2006	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			HOOK, JAMES F	
			ART UNIT	PAPER NUMBER
			3754	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/517,932

Applicant(s)

EDSTROM, STEN

Examiner

James F. Hook

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/26/05.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claims 6-11 are objected to because of the following informalities: the contain the term "a said" which is improper since if the specific limitation being referred to has already been positively recited then the term "said" only would apply, if the term is being newly recited then the term "a" only would apply, having both makes it unclear as to whether the specific term is a newly recited limitation or the same limitation set forth in previous claims. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the metes and bounds of the term "so-called fire proof paint" are when it is not clear what is meant by the term "so-called" thereby creating a situation where it is unclear what actual limits this claim has when such could be the proper term or not thereby rendering the claim indefinite.

Regarding claim 18, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 18, the word "means" is preceded by the word(s) "pretension through" and "said" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

### ***Specification***

The abstract of the disclosure is objected to because of the inclusion of legal phraseology such as the term "means". Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over NL 8,204,847 (from now on referred to as 847) in view of Gilleland. The 847 reference discloses the recited method for improving the inner walls of pipes 2 through spraying a fluid coating material towards the inner wall of the pipe, at least one material piece is divided in the longitudinal direction and held together under pretension through means, to a pipe piece with an outer diameter less than the inner diameter of the pipe, where the material piece is introduced before the spraying step to a location that requires improvement or repair, where the means holding the material piece can be

broken and can be considered to be a very thin material piece. The 847 reference discloses all of the recited structure with the exception of the material piece releasing potential energy under pretension and bear against the inner wall. The patent to Gilleland discloses the recited sleeve 12 provided in a pipe to be repaired, where the sleeve 12 is held in a collapsed state will open under pretension to bear against the wall. It would have been obvious to one skilled in the art to modify the material piece in 847 to allow it to utilize the inherent release of potential energy as the material expands to bear against the wall to be repaired as suggested by Gilleland where such would insure the material would achieve adequate contact with the pipe wall being repaired thereby saving time and money. It is considered an obvious choice of mechanical expedients to form the material of any thickness as such would only require routine experimentation to arrive at optimum values.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over 847 in view of Gilleland as applied to claims 1-10 and 18 above, and further in view of Kohichiro (SE 458950). The 847 reference as modified discloses all of the recited structure with the exception of placing the material opposite to a branch of a T of the pipe, specifically having a large enough space between longitudinal edges of the sleeve to allow such to be placed opposite to a T branch. The reference to Kohichiro discloses that it is old and well known in the art to provide repair sleeves with longitudinal slits that are spaced apart. It is considered merely intended use to place the sleeve across from a T branch of a pipe, and it would have been obvious to one skilled in the art to place the sleeve anywhere, including opposite to the T branch of a pipe by modifying the

Art Unit: 3754

sleeve in 847 as modified to have a gap between longitudinal edges as suggested by Kohichiro where such would prevent the blockage of the branch pipe when attempting to repair a portion of a pipe that was damaged opposite to the branch opening.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over 847 in view of Gilleland and Kohichiro as applied to claim 11, and further in view of Jansson (SE 343357). The 847 reference as modified discloses all of the recited structure with the exception of using easily breakable ribbons to hold the material sleeve closed. The reference to Jansson discloses that it is old and well known to provide a collapsed repair sleeve 2 with an easily breakable ribbon 7 to hold such in the collapsed state. It would have been obvious to modify the closing means in 847 as modified to be an easily breakable ribbon as such is an equivalent structure used to hold sleeves in collapsed condition as suggested by Jansson where such would insure easier breaking and deployment of the repair material thereby saving installation costs.

Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over 847 in view of Gilleland, Kohichiro, and Jansson as applied to claim 12, and further in view of Edstrom (SE 504663). The 847 reference as modified discloses all of the recited structure with the exception of disclosing the specific coating material being used. The reference to Edstrom discloses that it is old and well known in the art to provide a coating material which would include glass flakes in a polyester material or fire proof paint formed with mineral wool. It would have been obvious to one skilled in the art to modify 847 as modified by using a coating material containing mineral wool, or polyester material with glass flakes as the spray material used to coat insides of pipes

Art Unit: 3754

as suggested by Edstrom where such is an equivalent spray material used to coat pipes and would provide added protection thereby lengthening the life of the pipe. The specific use of the pipe is considered merely intended use, where the pipe lining method of 847 could be utilized in any pipe, and the size of the hole is considered to be merely a choice of mechanical expedients where one skilled in the art would only require routine experimentation to arrive at optimum values for the materials used to cover any sized hole.

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Brown, Jansson (328), Barber, Wrightson, Stanley, Renaud, Barton, Imoto (429 and 630), Wood, Adolphs, Walker, and Lippiatt disclosing state of the art repair methods for pipes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3754

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
James F. Hook  
Primary Examiner  
Art Unit 3754

JFH